



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

HUGHES LAW FIRM, PLLC
PACIFIC MERIDIAN PLAZA, SUITE 302
4164 MERIDIAN STREET
BELLINGHAM WA 98226-5583

COPY MAILED

FEB 01 2005

OFFICE OF PETITIONS

In re Application of :
Donald B. McDugle and Kevin D. Pattison :
Application No. 10/726,465 :
Filed: December 2, 2003 :
Attorney Docket No. P114519 :
Title: BOAT THRUSTER APPARATUS AND :
METHOD :

DECISION ON PETITION

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed July 12, 2004².

On December 2, 2003, the application was deposited, identifying Donald B. McDugle and Kevin D. Pattison as joint inventors. The application was deposited without an oath or declaration. On March 5, 2004, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that an executed oath or declaration which complies

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

² The petition contains a certificate of mailing dated July 6, 2004. It is noted that July 5, 2004 was a holiday.

with 37 C.F.R. §1.63 (the declaration failed to indicate the country of citizenship for either inventor) and a surcharge of \$65.00 were required. This Notice set a two-month period for reply.

Along with the instant petition, Petitioner has submitted the petition fee, the surcharge, the basic filing fee, and a two-month extension of time. Petitioner has also included a declaration that has been executed by joint inventor McDugle.

The petition has met requirements (1) and (2) above.

Regarding the third requirement, petitioner has failed to include a statement of the last known address of the non-signing inventor³.

Regarding the fourth requirement, petitioner has not shown that a *complete* copy of the application was sent to the non-signing inventor. Petitioner has stated that only the declaration and the Power of Attorney forms were presented to the non-signing inventor at a meeting on January 15, 2004. No mention is made of a copy of the application ever having been presented to the inventor for his review. As such, it is clear that the Rule 47 applicant did not present the inventor with a copy of the entire application.

It follows that one cannot refuse to sign something which one has not been presented with. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed⁴.

Regarding the fifth requirement, the declaration does not comply with 37 C.F.R. §1.63(a)(3) in that it fails to identify the country of citizenship for either inventor.

For these reasons, the petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.47(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner

³ See MPEP 409.03(e).

⁴ In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail⁵, hand-delivery⁶, or facsimile⁷.

The application file will be retained in the Office of Petitions for two (2) months.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁵ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁶ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁷ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.